

ESTTA Tracking number: **ESTTA775783**

Filing date: **10/11/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Dansko, LLC		
Entity	LIMITED LIABILITY COMPANY	Citizenship	Delaware
Address	33 Federal Road West Grove, PA 19390 UNITED STATES		

Attorney information	Camille M. Miller Cozen O'Connor 1650 Market Street, Suite 2800 One Liberty Place Philadelphia, PA 19103 UNITED STATES cmiller@cozen.com, treginelli@cozen.com, cbranka@cozen.com, jcloak@cozen.com Phone:215-665-7273
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### Applicant Information

Application No	87038358	Publication date	10/11/2016
Opposition Filing Date	10/11/2016	Opposition Period Ends	11/10/2016
Applicant	STEED LEATHER INC #1128 New York, NY 10016 UNITED STATES		

### Goods/Services Affected by Opposition


Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Handbags; Leather handbags; Luggage; Purses; Wallets
Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Belts; Blouses; Bottoms; Coats; Dresses; Jackets; Jeans; Pants; Shirts; Shoes; Shorts; Skirts; Socks; Suits; T-shirts; Tops; Underwear


### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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### Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2712957	Application Date	01/09/2002
Registration Date	05/06/2003	Foreign Priority Date	NONE

Word Mark	DANSKO
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1991/01/00 First Use In Commerce: 1991/01/00 FOOTWEAR, NAMELY, CASUAL OUTDOOR SHOES AND WORK SHOES FOR USE IN THE HEALTH CARE, FOOD SERVICE, EQUESTRIAN, AND GENERALSERVICE INDUSTRIES

U.S. Registration No.	4229847	Application Date	03/16/2012
Registration Date	10/23/2012	Foreign Priority Date	NONE
Word Mark	DANSKO		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1997/00/00 First Use In Commerce: 1997/00/00 leather and suede cleaning and protecting preparations; shoe creams; shoe cleaner; sponges impregnated with shoe polish; shoe care cleaning kits comprised of shoe cleaners and shoe brushes</p> <p>Class 018. First use: First Use: 2002/00/00 First Use In Commerce: 2002/00/00 all purpose carrying bags; handbags</p> <p>Class 025. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 clothing namely hats and shirts</p> <p>Class 035. First use: First Use: 1996/00/00 First Use In Commerce: 1998/00/00 retail footwear and apparel store services; on-line retail store services featuring footwear and apparel</p>		

U.S. Registration No.	3854991	Application Date	01/15/2010
Registration Date	09/28/2010	Foreign Priority Date	NONE

Word Mark	DANSKO
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2010/06/00 First Use In Commerce: 2010/06/00 Socks

U.S. Registration No.	3265194	Application Date	09/14/2006
Registration Date	07/17/2007	Foreign Priority Date	NONE
Word Mark	DANSKO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1991/01/00 First Use In Commerce: 1991/01/00 footwear; component parts of footwear, namely, tips and heel pieces; and leather shoes and imitation leather shoes		

Attachments	76357037#TMSN.png( bytes ) 85572046#TMSN.png( bytes ) 77913037#TMSN.png( bytes ) 78974374#TMSN.png( bytes ) DANS_5071_US_Notice_of_Opposition.pdf(605609 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Camille M. Miller/
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Name	Camille M. Miller
Date	10/11/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Dansko, LLC,	:	
	:	Opposition No.
Opposer,	:	
	:	U.S. Trademark Appl. No. 87/038358
v.	:	
	:	Filed: May 16, 2016
Steed Leather Inc.	:	
	:	
	:	Published: October 11, 2016
Applicant.	:	
<hr style="width:45%; margin-left:0"/>		Mark: DANCO ROSE & Design

USPTO-TTAB  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

Opposer, Dansko, LLC, a Delaware limited liability company with an address at 33 Federal Road, West Grove, Pennsylvania 19390 (“Opposer”), believes it will be damaged by the registration of the above-identified mark, applied for on the Principal Register by Applicant, Steed Leather, Inc., a New York corporation with an address of #1128 149 Madison Avenue, New York, NY 10016.

The grounds for the opposition are as follows:

**BACKGROUND OF OPPOSER AND OPPOSER’S MARKS**

1. Opposer is a leading footwear company and provider of a broad range of footwear, apparel, leather care, and related products and services.
2. Opposer has continuously used the word mark in interstate commerce since at least as early as 1991, in connection with the marketing, promotion, offering for sale and sale of footwear.

3. Opposer is the owner of, *inter alia*, the following U.S. Trademark Registrations:

Mark	SN/RN/Registration Date	Status	Goods/Services
DANSKO	76/57037/2,712,957/ May 6, 2003	Registered, Incontestable.	footwear, namely, casual outdoor shoes and work shoes for use in the health care, food service, equestrian, and general service industries in International Class 25
DANSKO	85/572046/4229847/ October 23, 2012	Registered.	leather and suede cleaning and protecting preparations; shoe creams; shoe cleaner; sponges impregnated with shoe polish; shoe care cleaning kits comprised of shoe cleaners and shoe brushes in International Class 3; all purpose carrying bags; handbags in International Class 18; clothing namely hats and shirts in International Class 25; and retail footwear and apparel store services; on-line retail store services featuring footwear and apparel in International Class 35
DANSKO	77/913037/ 3,854,991/ September 28, 2010	Registered, Incontestable.	socks in International Class 25
DANSKO	78/974374 / 3,265,194 / July 17, 2007	Registered, Incontestable	footwear; component parts of footwear, namely, tips and heel pieces; and leather shoes and imitation leather shoes in International Class 25

These marks are referred to collectively herein as the “Dansko Marks”. Copies of the above registrations for the Dansko Marks are attached as **Exhibit A**.

4. Registration Nos. 2,712,957, 3,854,991, and 3,265,194 are incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and thus serve as conclusive evidence of the validity of Opposer’s Dansko Marks pursuant to 15 U.S.C. § 1115(b).

5. Opposer has made substantial sales of goods and services under its Dansko Marks over the course of the many years that Opposer has used such marks.

6. Opposer has prominently used and continues to prominently use the Dansko Marks on and in connection with Opposer’s goods and services.

7. As a result of Opposer's long and continuous use and registration of its Dansko Marks, Opposer has developed substantial goodwill in the Dansko Marks and the public has come to recognize and associate the Dansko Marks with Opposer and Opposer's goods and services, including footwear.

8. Opposer's Dansko Marks are inherently distinctive source identifiers of Opposer and Opposer's goods and services.

### **BACKGROUND OF APPLICANT'S ACTIVITIES**

9. On May 16, 2016, Applicant filed an application (subsequently granted Application No. 87/038,358 by the USPTO (the "'358 Application'")) to register the mark shown below ("Applicant's Mark"):



for "Handbags; Leather handbags; Luggage; Purses; Wallets" in International Class 18 and "Belts; Blouses; Bottoms; Coats; Dresses; Jackets; Jeans; Pants; Shirts; Shoes; Shorts; Skirts; Socks; Suits; T-shirts; Tops; Underwear" long after Opposer first used and registered Opposer's Dansko Marks. The '358 Application claims that Applicant has an intent to use Applicant's Mark in connection with all of the above-referenceda

10. Applicant's Mark is nearly identical to Opposer's Dansko Marks, in which Opposer has prior rights.

11. The '358 Application is not limited to any particular channels of trade.

12. The goods identified in the '358 Application, namely, "Handbags; Leather handbags; Luggage; Purses; Wallets" and "Belts; Blouses; Bottoms; Coats; Dresses; Jackets; Jeans; Pants; Shirts; Shoes; Shorts; Skirts; Socks; Suits; T-shirts; Tops; Underwear" are identical or related to the goods Opposer offers under its Dansko

Marks and which are identified in Opposer's registrations for the Dansko Marks.

Consumers will expect that such goods originate from the same source.

13. Applicant's Mark, as identified in the '358 Application, consists of a mark that when used on or in connection with those goods identified in the '358 Application, is likely to confuse consumers into believing that Applicant or the goods offered by Applicant under Applicant's Mark are associated or otherwise affiliated with, or sponsored or endorsed by, Opposer when that is not the case.

14. Therefore, if Applicant is permitted to register Applicant's Mark, the registration will result in irreparable damage and injury to Opposer as it is likely to, among other things, cause confusion in the marketplace, thereby detracting from the considerable goodwill Opposer has accrued in the Dansko Marks.

**COUNT I**  
**LIKELIHOOD OF CONFUSION**

15. Opposer hereby incorporates by reference the allegations made in paragraphs 1-14 above.

16. Opposer's use and registration of Opposer's Dansko Marks are long prior to the filing date of the '358 Application.

17. Applicant was aware of Opposer's Dansko Marks at the time Applicant filed Applicant's Mark.

18. Applicant's Mark is confusingly similar to Opposer's Dansko Marks.

19. The goods identified in the '358 Application are related or identical to the goods offered by Opposer under the Dansko Marks.

20. Applicant's use of and (if granted) registration for Applicant's Mark is likely to confuse or deceive consumers into believing that Applicant, Applicant's Mark

and/or Applicant's goods offered in connection with Applicant's Mark are affiliated or associated with, or otherwise sponsored or endorsed by, Opposer, Opposer's Dansko Marks or Opposer's goods and services offered under the Dansko Marks, when that is not the case.

21. Applicant's use and registration of Applicant's Mark will inevitably lead to confusion, to mistake, or to deception of the public within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), all to Opposer's irreparable damage.

22. Registration of Applicant's Mark should be denied based on a likelihood of confusion with Opposer's prior registered Dansko Marks, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

**CLAIM FOR RELIEF/DAMAGE**

By reason of the foregoing, Applicant's registration of the mark herein opposed will cause injury and damage to Opposer's rights to Opposer's registered Dansko Marks and to Opposer's use thereof as described above.

WHEREFORE, Opposer prays that this opposition be sustained and that Application Serial No. 87/038,358 be refused registration.



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Camille M. Miller  
Chanel Lattimer  
COZEN O'CONNOR  
1650 Market Street, Suite 2800  
Philadelphia, PA 19103  
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Facsimile: (215) 665-2013  
cmiller@cozen.com

Dated: October 11, 2016

*Attorneys for Opposer,*  
Dansko, LLC

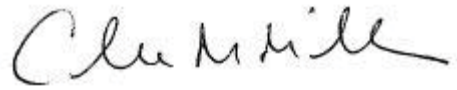
**CERTIFICATE OF SERVICE**

I hereby certify that on this 11<sup>th</sup> day of October, 2016, a copy of the foregoing Notice of Opposition was served on the Attorney of Record for Applicant and the Applicant, both by first-class mail, postage prepaid, addressed as follows:

Jason Jia  
Yerman & Jia Llc  
225 Broadway, 17th Floor  
New York, New York 10007

Steed Leather Inc.  
#1128  
149 Madison Ave.  
New York, New York 10016

Dated: October 11, 2016

A handwritten signature in cursive script, appearing to read "Camille M. Miller", written in dark ink.

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Camille M. Miller  
Attorney

**EXHIBIT “A”**

**Int. Cl.: 25**

**Prior U.S. Cls.: 22 and 39**

**United States Patent and Trademark Office**

**Reg. No. 2,712,957**

**Registered May 6, 2003**

**TRADEMARK  
PRINCIPAL REGISTER**

**DANSKO**

DANSKO, INC. (DELAWARE CORPORATION)  
8 FEDERAL ROAD  
WEST GROVE, PA 19390

TRIAN, AND GENERAL SERVICE INDUSTRIES,  
IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 1-0-1991; IN COMMERCE 1-0-1991.

FOR: FOOTWEAR, NAMELY, CASUAL OUT-  
DOOR SHOES AND WORK SHOES FOR USE IN  
THE HEALTH CARE, FOOD SERVICE, EQUES-

SER. NO. 76-357,037, FILED 1-9-2002.

MIDGE BUTLER, EXAMINING ATTORNEY

**United States of America**  
United States Patent and Trademark Office

**DANSKO**

**Reg. No. 4,229,847**

**Registered Oct. 23, 2012**

**Int. Cls.: 3, 18, 25 and 35**

**TRADEMARK**

**SERVICE MARK**

**PRINCIPAL REGISTER**

DANSKO, LLC (DELAWARE LIMITED LIABILITY COMPANY)  
33 FEDERAL ROAD  
WEST GROVE, PA 19390

FOR: LEATHER AND SUEDE CLEANING AND PROTECTING PREPARATIONS; SHOE CREAMS; SHOE CLEANER; SPONGES IMPREGNATED WITH SHOE POLISH; SHOE CARE CLEANING KITS COMPRISED OF SHOE CLEANERS AND SHOE BRUSHES, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 0-0-1997; IN COMMERCE 0-0-1997.

FOR: ALL PURPOSE CARRYING BAGS; HANDBAGS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 0-0-2002; IN COMMERCE 0-0-2002.

FOR: CLOTHING NAMELY HATS AND SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 0-0-1995; IN COMMERCE 0-0-1995.

FOR: RETAIL FOOTWEAR AND APPAREL STORE SERVICES; ON-LINE RETAIL STORE SERVICES FEATURING FOOTWEAR AND APPAREL, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 0-0-1996; IN COMMERCE 0-0-1998.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,712,953, 3,854,991 AND OTHERS.

SER. NO. 85-572,046, FILED 3-16-2012.

CHARLOTTE CORWIN, EXAMINING ATTORNEY



*David J. Kyros*

Director of the United States Patent and Trademark Office

# United States of America

United States Patent and Trademark Office

## DANSKO

**Reg. No. 3,854,991**

**Registered Sep. 28, 2010**

**Int. Cl.: 25**

**TRADEMARK**

**PRINCIPAL REGISTER**

DANSKO, LLC (DELAWARE LIMITED LIABILITY COMPANY)  
33 FEDERAL ROAD  
WEST GROVE, PA 19390

FOR: SOCKS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 6-0-2010; IN COMMERCE 6-0-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 3,264,216, 3,265,196, AND OTHERS.

SN 77-913,037, FILED 1-15-2010.

JENNIFER MARTIN, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

**Int. Cl.: 25**

**Prior U.S. Cls.: 22 and 39**

**United States Patent and Trademark Office**

**Reg. No. 3,265,194**

Registered July 17, 2007

**TRADEMARK  
PRINCIPAL REGISTER**

**DANSKO**

DANSKO, INC. (DELAWARE CORPORATION)  
8 FEDERAL ROAD  
WEST GROVE, PA 19390

FOR: FOOTWEAR; COMPONENT PARTS OF  
FOOTWEAR, NAMELY, TIPS AND HEEL PIECES;  
AND LEATHER SHOES AND IMITATION LEA-  
THER SHOES, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 1-0-1991; IN COMMERCE 1-0-1991.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,712,953 AND  
2,712,957.

SER. NO. 78-974,374, FILED 9-14-2006.

GISSELLE AGOSTO, EXAMINING ATTORNEY